

REMARKS:

Claims 1-28 are currently pending in the application. Claims 1-28 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,460,038 to Khan et al. ("Khan") in view of U.S. Patent No. 5,946,665 to Suzuki et al. ("Suzuki").

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) over Khan in view of Suzuki.

The Applicants respectfully submit that Khan or Suzuki either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 1-28. Thus, the Applicants respectfully traverse the Examiners obvious rejection of claims 1-28 under 35 U.S.C. § 103(a) over the proposed combination of Khan and Suzuki either individually or in combination.

For example, with respect to independent claim 1, this claim recites:

A global content directory for a distributed plurality of seller databases, each seller database being associated with a corresponding seller and distinct from other seller databases in the distributed plurality of seller databases, the global content directory comprising:

a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class;

one or more pointers associated with each product class in the plurality of product classes, each pointer identifying the seller database in the distributed plurality of seller databases in which product data enabling a product transaction is stored for products associated with the product class, the seller database identified by the pointer being associated with its corresponding seller and being distinct from the other seller databases in the distributed plurality of seller databases; and

a search interface operable to communicate, in response to a selection of a product class by a user of the global content directory, a search query for product data to the one or more seller databases identified by the one or more pointers associated with the selected product class, each seller database being associated with its corresponding seller and distinct from the other seller databases in the plurality of seller databases.
(Emphasis Added).

Independent claims 11 and 20 recite similar limitations. Khan or Suzuki either individually or in combination, fail to disclose each and every limitation of independent claims 1, 11, and 20.

For example, Khan fails to disclose one or more pointers associated with each product class in the plurality of product classes, each pointer identifying the seller database in the distributed plurality of seller databases in which product data enabling a product transaction is stored for products associated with the product class, the seller database identified by the pointer being associated with its corresponding seller and being distinct from the other seller databases in the distributed plurality of seller databases. Although Khan discloses a plurality of bookmarks (Figure 10), Khan does not disclose a pointer identifying a single bookmark, a plurality of bookmarks, or even a bookmark associated with its corresponding seller distinct from the other bookmarks in the plurality of bookmarks. Thus, Khan fails to disclose, teach, or suggest a plurality of seller databases, a plurality of distributed seller databases, and more specifically each pointer identifying the seller database in the distributed plurality of seller databases in which product data enabling a product transaction is stored for products associated with the product class, the seller database identified by the pointer being associated with its corresponding seller and being distinct from the other seller databases in the distributed plurality of seller databases.

The Applicants further submit that the Office Action acknowledges that Khan fails to disclose the emphasized limitations noted above in independent claim 1. Specifically the Examiner acknowledges that Khan fails to disclose the use of a search interface operable to communicate a search query for product data to one or more seller databases identified by the one or more pointers associated with the selected product class. (27 April 2005 Office Action, Page 3). However, the Examiner asserts that the cited portions of Suzuki disclose the acknowledged shortcomings in Khan. The Applicants respectfully traverse the Examiners assertions regarding the subject matter disclosed in Suzuki.

For example, Suzuki fails to disclose a search interface operable to communicate, in response to a selection of a product class by a user of the global

content directory, a search query for product data to the one or more seller databases identified by the one or more pointers associated with the selected product class, each seller database being associated with its corresponding seller and distinct from the other seller databases in the plurality of seller databases. Although Suzuki discloses a search server, (Abstract), the search server is merely an online shopping system using a communications network to provide online shopping information for a customer. Suzuki fails to disclose, teach, or suggest an online shopping system operable to communicate with a search query for product data identified by one or more pointers associated with the selected product class, or even online shopping information for a customer.

The Applicants respectfully submit that the Office Action alleges that Suzuki teaches that it is well known in the art to use a search interface operable to communicate a search query for product data to one or more seller databases identified by the one or more pointers associated with the selected product class. (27 April 2005 Office Action, Page 3). The Applicants respectfully traverse the Examiners assertions that Suzuki teaches that it is well known in the art to use a search interface operable to communicate a search query for product data to one or more seller databases identified by the one or more pointers associated with the selected product class. Suzuki fails to disclose, teach, or suggest the use of a search interface operable to communicate a search query for product data to one or more seller databases identified by the one or more pointers associated with the selected product class, let alone disclose, teach, or suggest that it is well known in the art to use a search interface operable to communicate a search query for product data to one or more seller databases identified by the one or more pointers associated with the selected product class.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Khan or Suzuki, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious

to one of ordinary skill in the art at the time of the invention to modify a global directory in Khan to include a search interface of Suzuki in order to search the different databases.

The Applicants further submit that these purported advantages relied on by the Examiner of incorporating a search interface of Suzuki are nowhere disclosed, taught, or suggested in Khan or Suzuki either individually or in combination. The Applicants respectfully request the Examiner to point to the portions of Khan or Suzuki which contain the teaching, suggestion, or motivation to combine these references for the purpose of incorporating a search interface of Suzuki into a global directory of Khan in order to search the different databases. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Khan or Suzuki either individually or in combination.

With respect to dependent claims 2-10, 12-19, and 21-28, claims 2-10 depend from independent claim 1, claims 12-19 depend from independent claim 11, and claims 21-28 depend from independent claim 20. As mentioned above, each of independent claims 1, 11, and 20 are considered patentably distinguishable over the proposed combination of Khan and Suzuki. Thus, dependent claims 2-10, 12-19, and 21-28 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants submit that claims 1-28 are not rendered obvious by the proposed combination of Khan and Suzuki. The Applicants further submit that claims 1-28 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 1-28 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-28 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

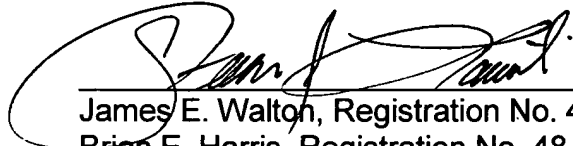
In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

7/5/05
Date


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